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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,360	03/30/2004	Katsunari Morishima	001309.00058	4113
22907	7590	01/27/2006	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER
			3677	
DATE MAILED: 01/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/812,360	MORISHIMA
	<b>Examiner</b>	<b>Art Unit</b>
	Katherine W. Mitchell	3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 November 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 August 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the nut retaining apparatus 283 must be shown or the feature(s) canceled from the claim(s). **“283’ appears in Fig 6, but it is pointing to the nut.** No new matter should be entered.
2. Revised Fig 5 is approved.
3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Examiner is not trying to be unduly critical, but finds the claims extremely hard to follow for a straightforward structure. First, examiner notes for clarity that "the body" is body 28, into which at least one nut holder 281 is mounted, and 281 holds nut 282..

7. Claims 1 and 15 now recite that the bolt is inserted into [an end surface of the body] from a direction inclined with respect to a direction tangent to the body. This is unclear- first, there are two "a direction"s, and assuming they are different, they should be first and second directions or otherwise distinguished. Examiner is reading the claim by assuming --a first direction, which is inclined with respect to a second direction, said second direction which is tangent to the body--. There are infinite directions tangent to the body 28, and infinite inclination directions relative to the tangents. Claims 2-14 and 16-22 are rejected as depending form claims 1 and 15 respectively.

8. Claims 15-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "The nut member" in claim 15 lines 6 and 7 lacks antecedent basis. Examiner assumes this is not the nut holder, but the actual nut member 282. Claims 16-21 are rejected as depending from claim 15.

9. In claim 13, "a bolt" is recited, which would indicate another bolt in addition to the bolt of claim 1 from which it depends. Examiner assumes --said bolt-- was intended.

10. Claim 14 is not a sentence. Examiner does not see how "the body of claim 1" is related to the rest of the claim. Examiner considers only that there is a member coupling device claimed of unspecified structure.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-2,4-6,8-10, 12--16,19-20, 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Schaaf USP 2820499.

Re claims 1 and 15: As best understood by examiner, (examiner notes nut retainer 283 has not been shown) Schaaf teaches a nut retaining apparatus mounted on a body (28) comprising a nut retainer (26 and 23) on an insertion end of the bolt insertion hole in the body, and against which the internally threaded (col 2 lines 32-36) nut member (10) abuts, and a nut holder (25) that supports the nut and is mounted on the body, thereby retaining the nut member at a position of the nut retainer. Fig 4 clearly shows the nut member and bolt inclined with respect to a direction tangent to the body. The bolt insertion direction is inclined with respect to a tangent to the body -- there is a tangent at a corner, and the bolt insertion direction is inclined with respect to that. Examiner notes applicant has not claimed direct mounting or connection, and it

has been held that the recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The nut member is retained and supported in the inclined direction continuous with the bolt hole (Fig 4).

Further Re claim 15: The predetermined position is determined by the bolt bore - see Fig 4.

Re claim 2 and 8-10, 16, The nut holder has side support surfaces, and end surface support and engaging portion as described as shown in Fig 4 and 3.

Re claim 4: The end surface has a hole 38 in communication with threaded nut hole - see Fig 3 and 4.

Re claims 5-6 and 19-20: The nut holder is mounted to the body from below something. Further, since applicant is claiming the combination nut retaining apparatus and body, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Re claims 12-14: The nut retaining apparatus is part of a member coupling device (the overall structure). It is capable of coupling a lateral frame member (which could be as represented by "42" in Fig 3 or 4) to the end surface of the body. It has been held that the functional "whereby" {and thereby -- examiner} statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).. A member coupling device can be considered the entire unit shown by bracket in Fig 1 and including body 28 of Fig 2-4.

Re claim 22: The nut retainer includes a side surface retainer for contact with a side surface of nut member, and an end surface retainer for contact with an end surface of nut member (Fig 3 --inside surface of 25, facing "19" is side surface retainer, surface at 23 against which nut member rests (in Fig 1-3) is the end surface retainer, as is surface 23 for other nut end.)

13. Claims 1--6,8-10,12-20 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Eaton USP 192620.

Re claims 1 and 15: As best understood by examiner, Eaton teaches a nut retaining apparatus mounted on a body (Fig 1-3) comprising a nut retainer (A) on an insertion end of the bolt insertion hole in the body (Fig 30, and against which the nut member (Fig 1 and 3) abuts, and a threaded nut holder (B) that supports the nut and is mounted on the body, thereby retaining the nut member at a position of the nut retainer. The bolt is inserted in a direction inclined with respect to a direction tangent to the body. The bolt insertion direction is inclined with respect to a tangent to the body -- there is a tangent at a corner, and the bolt insertion direction is inclined with respect to that. . Examiner notes applicant has not claimed direct mounting or connection, and it has been held that the recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The only structural limitations are a nut retainer provided on an insertion end of a body's hole, and a nut holder mounted on the body.

Re claims 12-14: The nut retaining apparatus is part of a member coupling device (the overall structure). It is capable of coupling a lateral frame member (which could be as represented as in Fig 3) to the end surface of the body. It has been held that the functional "whereby" {and thereby -- examiner} statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).. A member coupling device can be considered the entire unit shown including body of Fig 3.

Further Re claim 15: The predetermined position is determined by the bolt bore - see Fig 4.

Re claims 2 and 8,9,10,16: The nut holder/retainer (examiner is not sure of the difference in a nut retainer and a nut holder) B has side support surfaces (v-shaped groove Fig 1) and end surface support (flat surface of A which directly abuts the nut in Fig 1 and 3). The engaging portion is the side of A have spurs t.

Re claims 3,17: The side supports are vee shaped groove - see Fig 1.

Re claims 4 and 18: The end surface has a hole in communication with threaded nut hole - see Fig 3.

Re claims 5-6 and 19-20: The nut holder is mounted to the body from below something. Further, since applicant is claiming the combination nut retaining apparatus and body, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Re claim 22: The nut retainer includes a side surface retainer for contact with a side surface of nut member, and an end surface retainer for contact with an end surface

of nut member (Fig 1 --surface of notch "f" is side surface retainer, flat surface against which nut member rests (the nut end not visible in Fig 1) is the end surface retainer.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 7,11,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaaf USP 2820499.

Re claims 7,11, and 21: As discussed above, Schaaf teaches all the limitations except the material of construction as resin or aluminum. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have selected resin or aluminum as the material of construction, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of engineering choice from known alternatives. *In re Leshin*, 125 USPQ 416. The method of forming the device (i.e., by die casting) is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

***Response to Arguments***

16. Applicant's arguments filed 11/29/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Fixed or stationary, non-swivel mounting) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). "Mounted" does not require fixed positioning.

**mount (mount) verb**

*verb, transitive*

2. To place oneself upon; get up on: *mount a horse; mount a platform.*
5. To set in a raised position: *mount a bed on blocks.*
6. a. To fix securely to a support: *mount an engine in a car.* b. To place or fix on or in the appropriate support or setting for display or study: *mount stamps in an album; mount a specimen on a slide.*
10. a. To set in position for use: *mount guns.* b. To carry as equipment: *The warship mounted ten guns.*<sup>1</sup>

#### ***Response to Amendment***

17. The "Remarks, claims, and abstract" sections filed 11/8/2005 appear to have the wrong serial number on them. The claims have been resubmitted 11/29/2005 with the correct serial number. It appears that they are the correct remarks and abstract for this case. Since examiner is prone to make cut and paste typing errors herself, she assumes this is a cut and paste error also. However, prior to any allowance, they should be resubmitted with the correct headings, as the automated printing process is likely to encounter problems.

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<sup>1</sup>Excerpted from *The American Heritage Dictionary of the English Language, Third Edition* Copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from Lernout & Hauspie Speech

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

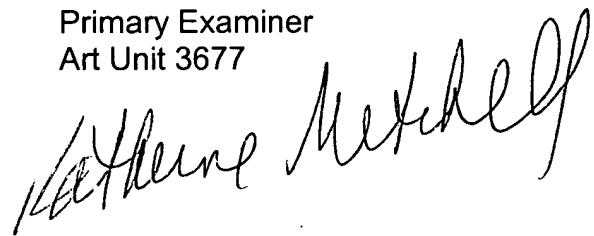
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell  
Primary Examiner  
Art Unit 3677

Kwm  
1/20/2006

A handwritten signature in black ink, appearing to read "Katherine W. Mitchell".